

### **REMARKS**

Support for claim amendments and the new claims can be found in the specification, at least in paragraphs [0025] – [0068]. Reconsideration of the action and further consideration are respectfully requested.

#### **Examiner Interview**

The Applicant thanks Examiners Brandenburg and Bramer for the courtesy of an interview on November 2, 2009. The Applicant and the Examiners discussed the amended features of claim 1, namely the “generating, at a server, an electronic advertisement” and “including the electronic advertisement in a first electronic document” features. The Examiners stated that further search and consideration are required

#### **§ 112 Rejections**

Claims 1-2, 18-19, and 35-36 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 18-34 were rejected under U.S.C. § 112, second paragraph, as allegedly being indefinite. In order to expedite prosecution, claims 1-2, 18-19, and 35-36 have been amended. Applicant respectfully requests withdrawal of the § 112 rejections.

Claims 18-34 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claim 18 recites “means for” and the Office Action states that “the Examiner is unable to find a specific definition in the Applicant’s specification as to what is deemed a means for. As such, the Examiner respectfully requests that if the Applicant is indeed invoking 35 U.S.C. 112, sixth paragraph, that they provide the specific means for to the Examiner. If this information is not provided to the Examiner, then the next Action on the merits will reflect the Examiner is interpreting this to mean 35 USC 112, sixth paragraphs is not being invoked. See MPEP 2181.” See Office Action, page 6. The Applicant respectfully disagrees. Claim 18 recites “means for” and Applicant intends to invoke 35 U.S.C. § 112, sixth paragraph. Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function. See MPEP

2106. Therefore, claim 18 is not indefinite because it is to be construed under 35 U.S.C. § 112, sixth paragraph.

§ 101 Rejections

Claims 1-17 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In order to expedite prosecution, claim 1 has been amended. Applicant respectfully requests withdrawal of the § 101 rejections.

§ 103 Rejections

Claims 1-12, 14-15, 18-29, 31-32, 35-46 and 48-49 and 52 are were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Publication No. 2003/0146939 (Petropoulos). Claims 13, 16, 30, 33, 47, and 50 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of U.S. Publication No. 2002/0165767 (Ogura). Claims 17, 34, and 51 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of Ogura as applied to claims 13, 16, 30, 33, 47 and 50 above, in further in view of U.S. Publication No. 2003/0032677 ("Morgenthaler"). Claim 51 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of Morgenthaler. Applicant respectfully traverses the rejection.

Claim 1 recites "**identifying, at a server, an electronic advertisement**, the electronic advertisement **including a compact display format, an expanded display format, and code** a client device uses to transition the electronic advertisement from the compact display format into the expanded display format . . . delivering, from the server at a first time, the first electronic document including electronic advertisement, the electronic advertisement initially displayed in the first electronic document in the compact display format . . . **identifying a second electronic document including content from the referenced network location** associated with the menu option selected; **including the electronic advertisement in the second electronic document**; and **delivering**, from the server at a second later time, **the second electronic document including the electronic advertisement.**"

First, the relied upon portions of Petropoulos do not **identify** any electronic advertisement, much less "identifying, at a server, an electronic advertisement **including** a

**compact display format, an expanded display format, and code** a client device uses to transition the electronic advertisement from the compact display format into the expanded display format,” as recited in claim 1.

The relied upon portions of Petropoulos describe allowing a user to see both a search result and a preview of the underlying information described by the search result (i.e., a preview of the webpage linked to by the result). However, Applicant respectfully asserts that the relied upon portions of Petropoulos related to a search result and associated preview web page is not the same as Applicant's claimed electronic advertisement including a compact and expanded display format as well as code that allows the client to transition from a compact display format into an expanded display format, as recited in claim 1. The search result page (nor any individual search result entry) displayed in the Petropoulos system does not include all three of “a **compact display format, an expanded display format, and code** a client device uses to transition the electronic advertisement from the compact display format into the expanded display format,” as recited in claim 1. At most, the relied upon portions of Petropoulos describes that the preview information associated with the search result can include an advertisement but does not teach or suggest that the search result, the alleged electronic advertisement, includes **two formats** of the same advertisement (compact and expanded) as well as **code** the client uses to transition between the two.

Furthermore, the relied upon portions indicate that a search result is delivered *then* a preview can be prompted. Even if this is construed as being Applicant's claimed two display formats, which point Applicant does not concede, there is not teaching or suggestion in the relied upon portions that two display formats of an advertisement are delivered as part of a single electronic advertisement. Rather, as describe in the relied upon portions of the reference, the two different elements are delivered sequentially at two different times (i.e., at a first time the search result is delivered, then at a second time after the user has selected a particular result a preview is delivered). Furthermore, the search result and the preview do not also include code that allows for the transition. For at least this reason alone, Applicant respectfully asserts that the relied upon portions of Petropoulos do not teach or suggest Applicant's claimed electronic advertisement including the compact and expanded display formats as well as the code that allows a client to transition between the two.

Second, the relied upon portions of Petropoulos do not teach or suggest “delivering . . . the first electronic document **including** the electronic advertisement, the electronic advertisement initially displayed in the first electronic document in a compact display format.” The search results, the alleged electronic advertisement, as discussed above, do not include the “compact display format, an expanded display format, and the code” that are included in the electronic advertisement of claim 1. Therefore, Petropoulos does not teach or suggest “delivering . . . the first electronic document including the electronic advertisement, the electronic advertisement initially displayed in the first electronic document in a compact display format,” as recited in claim 1, since Petropoulos does not disclose an electronic advertisement.

Third, the relied upon portions of Petropoulos do not teach or suggest “**identifying** a second electronic document including content from the referenced network location associated with the menu option selected; [and] **including the electronic advertisement in the second electronic document**,” as recited in claim 1. In fact, the concept of “identifying” a document and “**including the electronic advertisement in the second document**” are completely missing from the relied upon portions of Petropoulos.

Finally, the relied upon portions of Petropoulos do not teach or suggest “delivering, from the server at a second later time, **the second electronic document including the electronic advertisement**.” The Examiner agrees that Petropoulos does not teach or suggest “delivering, from the server, a second electronic document including content from the referenced network location associated with the menu option selected and including” the second electronic advertisement as recited in claim 1. *See* Office Action, page 11. The Office Action states “Petropoulos does teach enabling active hyperlinks in preview windows that when clicked result in a call to the referenced page as well as enabling further mouse-over, which allows the user to use mouse-over in the preview pane . . . it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering content associated with a selected menu option including the advertisement in the expanded display format . . . Furthermore, the Examiner notes that although Petropoulos does not explicitly teach what exactly occurs in the main browser window when they hyperlink in the preview window is selected, it would be an obvious design choice to program the browser to display in such a

fashion as claimed in the instant application.” *See* Office Action, page 12. Applicant respectfully disagrees.

The Examiner appears to be taking of Official Notice with regard to the “delivering . . . the second electronic document **including the electronic advertisement**” feature above by stating that Petropoulos does not teach the feature yet concluding that it would have been obvious to modify Petropoulos to include the claim feature. The Applicant refers the Examiner to MPEP § 2144.03. In relevant part, MPEP § 2144.03 states, “If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” Applicant submits that the Examiner has made a generalized statement without any documentary evidence to support it. Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicant submits that the Examiner must provide “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” *In re Soli*, 317 F.2d 941, 946, 137 USPQ 797, 801 (CCPA, 1963).

The relied upon portions of Ogura and Morgenthaler also do not teach or suggest the claimed subject matter missing from Petropoulos namely “identifying, at a server, an electronic advertisement, the electronic advertisement including a compact display format, an expanded display format, and code a client device uses to transition the electronic advertisement from the compact display format into the expanded display format . . . delivering, from the server at a first time, the first electronic document including electronic advertisement, the electronic advertisement initially displayed in the first electronic document in the compact display format . . . identifying a second electronic document including content from the referenced network location associated with the menu option selected; including the electronic advertisement in the second electronic document; and delivering, from the server at a second later time, the second electronic document including the electronic advertisement,” as recited in claim 1.

Accordingly, the relied upon portions of Petropoulos, Ogura, and Morgenthaler taken alone or in combination, do not teach or suggest each and every element of claim 1, and therefore, cannot support a rejection of this claim under 35 U.S.C. § 103(a). Reconsideration and withdrawal of the rejection are respectfully requested and deemed appropriate for at least these

reasons. Claims 2-17 depend from claim 1 and are allowable for at least the same reasons set forth above with respect to claim 1.

Claim 18 is directed to an apparatus that includes “electronic advertisement identification means for identifying an electronic advertisement, the electronic advertisement including a compact display format, an expanded display format, and code a client device uses to transition the electronic advertisement from the compact display format into the expanded display format, the compact display format including an associated expansion icon, and the expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option; electronic advertisements delivering means for delivering, at a first time, the first electronic document including the electronic advertisement, the electronic advertisement initially displayed in the first electronic document in the compact display format; selection receiving means for receiving a user selection of one of the one or more menu options after the compact display format of the electronic advertisement has been transitioned into the expanded display format; and electronic advertisement identifying means for identifying a second electronic document including content from the referenced network location associated with the menu option selected; electronic advertisement including means for including the electronic advertisement in the second electronic document; and the electronic advertisement delivering means delivering at a second later time, the second electronic document including the electronic advertisement..” Claim 18 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 19-34 depend from claim 18 and are allowable for at least the same reasons set forth above with respect to claim 18.

Claim 35 is directed to an apparatus including a server for performing operations comprising “identifying an electronic advertisement, the electronic advertisement including a compact display format, an expanded display format, and code a client device uses to transition the electronic advertisement from the compact display format into the expanded display format, the compact display format including an associated expansion icon and the expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option; delivering, from the server at a first time, the first electronic document including electronic advertisement, the electronic advertisement initially displayed in the first electronic document in the compact display format; receiving, at

the server, a user selection of one of the one or more menu options after the compact display format of the electronic advertisement has been transitioned into the expanded display format; identifying a second electronic document including content from the referenced network location associated with the menu option selected; including the electronic advertisement in the second electronic document, the electronic advertisement displayed in the second electronic document in the expanded display format; and delivering, from the server at a second later time, the second electronic document including the electronic advertisement.” Claim 35 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 36-47 depend from claim 35 and are allowable for at least the same reasons set forth above with respect to claim 35.

Claim 52 is directed to a method including “receiving at a server, from a publisher, a request for an advertisement to be included in a first electronic document associated with publisher; identifying an electronic advertisement responsive to the request the electronic advertisement including a reference to a network location for retrieving specified content associated with the electronic advertisement ; delivering, from the server at a first time, the electronic advertisement to be included in the first electronic document; receiving a user selection of the electronic advertisement; identifying a second electronic document including content from a referenced network location associated with the selected electronic advertisement; including the electronic advertisement in the second electronic document; and delivering, from the server at a second later time, the second electronic document including the electronic advertisement; wherein the delivering, receiving the user selection, and including are performed by one or more computers.” Claim 52 is allowable for at least some of the same reasons set forth above with respect to claim 1.

New claim 53 recites “identifying, at a server, an electronic advertisement, the electronic advertisement including a reference to a network location for retrieving specified content associated with the electronic advertisement; delivering, from the server at a first time, the first electronic document including the electronic advertisement; receiving, at the server, a user selection of the electronic advertisement; identifying a second electronic document including content from the referenced network location associated with the electronic advertisement; including the electronic advertisement in the second electronic document; and delivering, from the server at a second later time, the second electronic document including the electronic

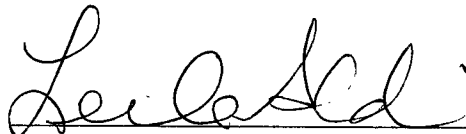
advertisement; wherein the delivering, from the server at a first time, receiving, including, and delivering, from the server at the second later time are performed by one or more computers.”

Claim 53 is allowable for at least some of the same reasons set forth above with respect to claim 1.

Conclusion

For the foregoing reasons, the Applicant submits that all the claims are in condition for allowance. By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the Applicant's decision to amend or cancel any claim should not be understood as implying that the Applicant agrees with any positions taken by the Examiner with respect to that claim or other claims. Please apply any charges not otherwise paid or any credits to deposit account 06 1050.

Respectfully submitted,



Leila R. Abdi  
Reg. No. 52,399

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Customer No. 26192  
Fish & Richardson P.C.  
Atlanta, GA 30309  
Telephone: (404) 892-5005  
Facsimile: (877) 769-7945